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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/606,878 06/29/00 UCHIYAMA

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IM22/0112
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NEW YORK NY 10038

EXAMINER

TALBOT, B

ART UNIT

PAPER NUMBER

1762

DATE MAILED:

01/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/606,878

Applicant(s)

UCHIYAMA, AKIRA

Examiner

Brian K Talbot

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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1. This application is a Divisional Application of US Ser. No. 09/007,129, filed 3/23/99, now US Pat. No. 6,087,018. Claims 25-39 have been canceled. Claims 1-24 remain in the application.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

No ornaments or electronic devices are claimed. In addition, the surface treatment is performed on a titanium surface but not recited.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the term "surface adhesion substances" is vague and indefinite. Do these substance provide adhesion or prevent it? What substances? Clarification is requested.

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The terms "removing" and "forming" are vague and indefinite. No processing steps are recited as to how these steps are performed.

With respect to claim 2, the term "machine works" is vague and indefinite. What machine works and how are the substances a result of that?

With respect to claim 17, the term "first" lacks antecedent basis. Are there more than one substance?

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The machining step to form a roughened surface which results in foreign materials and/or an oxide layer is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for facing cases for watches made of titanium, does not reasonably provide enablement for any other titanium surface such as those for cutting tools. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly

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connected, to make and/or use the invention commensurate in scope with these claims. Claims should be amended to recite such a limitation, i.e. "a titanium facing case for watches".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted state of the art (specification, pg. 1-3) in combination with either Thoma (4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861) or Fahrmbacher-Lutz et al. (4,525,250).

Applicant's admitted state of the art (specification, pg. 1-3) teaches that watches made of aluminum or aluminum alloys covered with a transparent protective film are known. The specification further teaches that titanium and titanium alloys are known to be utilized in forming watches, however, oxidation of the titanium materials is a problem.

Applicant's admitted state of the art (specification, pg. 1-3) fails to teach removing "adhesion substances" from the titanium surfaces prior to applying the transparent protective film.

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Thoma (4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861) or Fahrmbacher-Lutz et al. (4,525,250) all individually teach the importance of removing "native oxides, i.e. titanium oxide" and impurities on the surface of titanium prior to subsequent plating processes.

While the Examiner acknowledges the fact that the references teach a metal plating step as opposed to a transparent protective layer, i.e. glass, the references are relied upon for teaching the known "pretreatment" steps to form a "prepared clean titanium surface" prior to any subsequent coating. It is the Examiner's position that one skilled in the art would recognize that the problems associated with titanium oxide and other impurities would also effect not only metal coating but other coatings as well. Hence, it is the Examiner's position that one skilled in the art at the time the invention was made would have had a reasonable expectation of achieving similar success regardless of the type of subsequent coating.


With respect to the claimed "pretreatment steps" as well as the compositional make up of the glass layer, it is the Examiner's position that these are all "result effective" variables which can be optimized by one skilled in the art. In addition, one skilled in the art would have had a reasonable expectation of achieving similar success regardless of which conventional technique was utilized without the showing of unexpected results.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 7AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-6357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.


Brian K Talbot
Primary Examiner
Art Unit 1762

BKT
January 11, 2001